Supreme Court of the United States.

No. 38.

PAUL C. COFFIN,

Appellant,

vs.

JAMES B. OGDEN and
LUCIUS WOODRUFF,

Appellees.

Brief for Appellant.

BY

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STATEMENT.

This is a suit in equity on a patent for an improvement in a door lock.

The Court below erred in dismissing the bill.

The patent is a re-issue to Charles A. Miller, assignee of W. S. Kirkham, dated the 27th day of January, 1863.

The bill is in the usual form. The answer is in the usual form, setting up an alleged prior invention of one Barthol Erbe.

There is no question as to the title of the Complainant. This is admitted, folio 21, of the record.

There is no question as to the infringement. A lock of the appellees is admitted in evidence, and marked "Exhibit D," folio 51, of the record, and this lock is proved to be like the one patented. [See Renwick's Deposition, folios 22 and 23.] No evidence was offered to the contrary.

There are two questions in the case: one as to whether or not the alleged prior invention of Erbe, as proved, was sufficiently developed to amount to a completed prior invention; the other is, whether under the circumstances, even conceding that Erbe did give birth to the invention so that it temporarily drew the breath of life, sufficient was done with it to invalidate the subsequent patent of Kirkham for his subsequent and independent invention.

That Kirkham made his invention and put it into public use before Erbe attempted either to develop his invention or make it known, is proved, and not understood to be disputed.

First—The proof shows that Erbe, as early as the 1st of January, 1861, made a lock containing the elements of the combination patented, and showed it, to some extent, to three persons—Brosi, Patterson, and Masta—two of whom were lock-makers, and the other was a pattern-maker. That Erbe then handed this lock to his employers, Jones, Wallingford & Co., and that this was the last he knew of it.

Second—That nothing more was done by Erbe respecting the invention until in the Fall of 1864, when he ap-

plied for a patent, being four years after the time of his alleged invention.

Third—That Kirkham made the invention in March, 1861, and applied for and obtained a patent, which was dated the 11th of June, 1861, being three years before Erbe made any application for a patent.

Fourth—That Erbe never put the invention into practical use, or caused it to be done, and that it never went into practical use from his invention, or from anything which he (Erbe) did or caused to be done, and that, therefore, whether or not it was reduced to practical form by Erbe, was never illustrated, but was a mere matter of opinion, and so remains to the present day.

I.

THE PATENT BEING *PRIMA FACIE* EVIDENCE OF THE NOVELTY OF THE INVENTION PATENTED, THE ONUS OF PROOF TO SHOW A WANT OF NOVELTY IS ON THE DEFENDANTS, AND TO MAINTAIN SUCH DEFENCE, THEY MUST PROVE IT BEYOND A REASONABLE DOUBT.

Potter *v.* Holland, 1 Fisher, 387.
Washburn *v.* Gould, 3 Story, 142.
Allen *v.* Blunt, 2 Wood. & Minot, 145.
Union Sugar Refinery *v.* Matthiessen, 2 Fisher, 600.
Ransom *v.* Mayor of N. Y., 1 Fisher, 252.
Allen *v.* Hunter, 6 McLean, 303.

Poppenhusen *v.* N. Y. Gutta Percha Comb Co., 2 Fisher, 62.

Waterbury Brass Co. *v.* N. Y. &c. Co., 3 Fisher, 43.

Proof to show want of novelty which only raises a doubt is insufficient, and it is immaterial whether the doubt arises from the insufficiency of the proof of the facts, or the insufficiency of the facts proved.

To succeed in an attempt to invalidate a patent by proof of a prior production, all of the following several things must be established:

First—It must be proved beyond a reasonable doubt that the prior production was *completed* in practical form.

Second—It must be proved beyond a reasonable doubt that the prior production was *the thing* patented.

Third—It must be proved beyond a reasonable doubt that some *publicity* was given to the prior production.

Fourth—It must appear beyond a reasonable doubt that the publicity proved was such as to furnish some assurance, at least, that the public would have received the benefit of the patented invention from such prior production of it.

These facts must *all* be established beyond a reasonable doubt. Leaving any one of them in serious doubt would be as fatal to the defence of prior invention as if all of them were so left. Anything short of such requirement would be in conflict with the policy, purpose and principles of the patent law.

There must be no reasonable doubt of the truth of the evidence of the prior production.

There must be no reasonable doubt respecting the extent of development or completeness of the prior production.

There must be no reasonable doubt as to whether or not the prior production was the invention patented.

There must be no doubt respecting the publicity being sufficient to have given the invention to the public.

There must not only be proof on *all* of these points, but there must be sufficient proof to clear away all reasonable doubt of the existence of each of them.

The defence set up in this case, it is respectfully submitted, fails not only on one or some of those points, but it fails on all of them.

II.

THE PROOF FAILS TO ESTABLISH THAT ERBE DID ENOUGH OR CARRIED HIS EXPERIMENT FAR ENOUGH TO AMOUNT TO A COMPLETED INVENTION.

First—Erbe, at most, made only one lock prior to the completion by Kirkham of his invention, and his construction of two finished locks and his applying for and obtaining a patent.

So the Court below decided, and such is the evidence.

From the Appellees' own testimony, it appears that Kirkham had his invention planned as early as the first of March, 1861; that in two weeks thereafter patterns were made, and that immediately thereafter two complete locks were constructed, of which Exhibit C is one; [folio 123, answers 8 and 12, and folios 124 and 125, answer 19 to 23 both inclusive.]

The proofs entirely fail to show that Erbe, prior to that time, did anything more than to make one experimental lock, and show it to three persons.

Masta, one of the Appellees' witnesses, was a pattern-maker in the factory where Erbe worked, and Erbe showed him the lock which he made about the 1st of January, 1861, once while on his way to church; folio 84, answer 8. But Masta neither saw nor heard of any other like it until long after Kirkham's patent was issued, and the locks had gone into use under it, and litigation had been started, when he saw another in a lawyer's office; [folio 84, answers 32, 33 and 34, and folio 85, answer 38.]

All that the testimony of this witness tends to prove is, that Erbe one day, while on his way to church, in passing the witness' house, stepped in and showed him the lock, and then put the lock into his pocket; [folio 82, answer 8, folio 85, answer 40.]

This was the only time that the witness ever saw the lock, until about three years before he was examined, which was in January, 1869; [folio 84, answer 33.] That is, the witness thus briefly had his attention called to the lock about Christmas, 1860, and never saw it again, or

one year

one like it, until after the lapse of over eight years, and until long after Kirkham's invention had been made, his patent obtained, the patent re-issued, and purchased by the complainant, and the invention become public under the patent.

Patterson, another of the Appellees' witnesses, was superintendent of the factory where Erbe worked, and Erbe once, in the pattern-room, showed him the lock of the 1st of January, 1861, [folio 94, answer 30,] but Patterson could not say that he saw any other like it; [folio 91, answer 8, and folio 94, answer 31.] The Appellees, however, found a man who worked in the shop, a foreigner, by the name of Brosi. This man was willing to undertake to swear that he saw two other locks of the same kind, but the Court below held that only *one* was made. This witness, as decided by the Court, it will be found, even from an examination of his own deposition, is not at all reliable. He, like many other foreigners, seemed to have no idea that he was expected to tell the truth; he answered questions at random, stating just what he happened to think of at the time, without any reference to what had actually occurred, or even to what he himself had just before said; a little attention to his deposition on the number of locks Erbe made, as well as other points, will show how little his testimony is worthy of credit.

Brosi's story with regard to the first lock is, that one day somewhere about Christmas he went to Erbe's house on business. He refuses to tell what business it was; that he was there in all about two hours; that after he had been there about half an hour, Erbe showed him the

lock; that no one else was present but Erbe's wife. [Folio 68.] This is the only lock which, in his direct examination, he says he saw or mentions as having seen.

On his cross-examination [folio 73, answer 100] he says he saw two more. He thus expresses it:—

> "I saw a couple of them making; Erbe made a couple after he showed me that one."

Now, on examination, it will be found that this pretence that Erbe made two more, is without foundation, unless it refers to a period of time long after the Kirkham patent was issued, re-issued and sold, and locks were being made and sold under it, and about which a controversy had arisen, in which case it would be of no consequence to this controversy.

In respect to these two alleged locks Brosi says [folio 73, answer 103] he "saw them a great many times at the shop of Jones, Wallingford & Co.," and that Erbe had them there. At same folio, answer 109, he says he saw Erbe have those locks at the shop only a "couple of times," thus changing his "great many times" to twice. At the same folio, answer 105, he says he "saw John Rabitzky *once* looking at it."

At folio 73, answer 109, he changes his *once* to twice. At folio 75 he swears thus:—

> "X Q. 130. Can you swear and do you swear that the lock which you say was on the office-door of Jones, Wallingford & Co. had a divided or double hub on it?
>
> "A. I never looked about that; we never had another lock in the shop like this.

"X Q. 131. Like which?

"A. Like Exhibit A.

"X Q. 132. Now, have you not already sworn on this examination that Erbe made two other locks like Exhibit A., after he showed you the one at his house?

"A. I did.

"X Q. 133. Have not you also sworn on this examination that you never had another lock in the shop like Exhibit A?

"A. No."

Here he flatly contradicts himself in the short space of answering three questions. At folio 76 he swears thus:

"X Q. 139. Did you see Erbe make those two locks in that shop?

"A. I saw him working at them. Yes, I saw him make them.

"X Q. 140. Then you mean, do you, that you saw him make the whole of these two locks, and all their parts, from beginning to end?

"A. I saw them when he had them finished.

"X Q. 141. Question repeated.

"A. I do mean so."

Here he swears that he saw them in progress from beginning to end, while at folio 73 he swears that he only saw them twice, and that that was when Erbe showed them to John Rabitzky; and yet when asked again how many times he saw Rabitzky looking at them, his answer is:—

"I do not know. I did not watch him."

At folio 77, in reference to these two locks, he swears thus:—

"X Q. 148. When did you last see either of those two locks?

"A. I cannot remember that any more.

"X Q. 149. State as nearly as you can when you last saw either of those locks?

"A. I cannot give any better answer than I have done."

On a re-examination, on the part of Appellees [folio 80], to the question as to how he knew that the lock, which he said he saw on a door was the *same one* which Erbe had shown him about Christmas, 1860, he answers thus:—

"It was the same lock because we never had another lock before in the shop like it."

And then to the question [folio 81], put by the Appellees' counsel:—

"Might not Erbe have made another lock just after Christmas, 1860, and which lock was the one which went onto the office door?"

He answers—

"No, sir."

Here he not only says that there was only one lock of the kind in question, and that Erbe *could* not have made another just after Christmas, 1860, which went onto the

office door, and that if Erbe had made another such lock he would have known it, but this statement he makes after to the question, [folio 77]:—

> "Was it one of those two locks which was put on the office door?"

He answers—

> "I told you that I did not know whether it was one of these or the original one; I did not ask him."

Now, if it were possible to believe, from the testimony of this witness, that two locks were made by Erbe after the one exhibited about Christmas, yet there would be no evidence that they were made before the Kirkham patent was issued, and locks put in the market under it, and, therefore, such evidence would be unavailable against the Kirkham patent.

At folio 73, this witness says that the two additional locks were made at the time Jones, Wallingford & Co. resumed work again; and at folio 76, answer 137, he says that this resumption of work "was about half a year after he showed me the one at the house;" and at folio 70 he says, "it was anyhow over half a year."

This would bring the making of the two additional locks about the first of July, 1861, some three months after Kirkham's invention was completed and locks were constructed according to it, and one month after the issuing of the Kirkham patent.

It is therefore respectfully submitted that there is no evidence to sustain the position that more than one lock

was made by Erbe, and that if there was, it was not done in time to interfere with the Kirkham patent.

But there is not only an entire failure on the part of the Appellees to prove that Erbe made more than one lock prior to the patent of Kirkham, but there is positive proof on the part of the Appellant that there was only the one lock. This proof is the best and most reliable which could possibly be had. It is the deposition of Erbe himself [folio 48, answer 9], where he says he made three locks, but that one of the last two was as late as when he applied for a patent, and was his Patent Office model, and that the other of the last two was still later.

This application of Erbe for a patent was not until in 1864. See Patterson's testimony [folio 94, answer 32].

Second—The next point respecting the alleged invention of Erbe, is that the lock which he exhibited about the 1st *of January*, 1861, *was never put upon a door, or practically tested in any other way.*

Patterson does not say that he ever saw that lock on a door, or that it ever was put upon a door. Although obviously a very willing witness, all he can or does say on that subject is the following:—

> "Q. 7. Do you remember whether the lock so shown you, or one like it, was at or about that time put on the office door of Jones, Wallingford & Co.
>
> "A. It was our uniform practice to put all new locks on the doors about the office to test them, and I believe that one was put on, but at this distance of time, I cannot say positively that it was."

Henry Masta never saw the lock but once, and then Erbe showed it to him while on his way to church [folio 82]. He never saw it on a door.

Here, then, were the superintendent and the pattern-maker, to whom the lock was shown by Erbe, the very persons above all others to whom Erbe would have shown the operation of the lock on the door, if it had ever been put onto any door, and yet not one of them ever saw the lock on a door. Is it at all probable that the lock was put upon a door without these men knowing it? The absence of any knowledge on the part of either of these witnesses of the lock ever being on a door or in any way tested, is a very strong circumstance to show that it never was tested.

What evidence, then, do the Appellees rely on to support their pretence that this lock was put upon a door? Simply the statement of their same indomitable Dutchman, Brosi This man, at folio 66, says he saw the lock on a door. But from an examination of his deposition on this point, it will be found that his testimony is entirely unreliable on this, as well as respecting the making of two additional locks.

This witness does not pretend to give the time when he saw such a lock on a door; he only says generally that it was during the winter.

At folio 74, he says:—

> "I saw one working on the door of the office. I cannot tell whether it was one he made afterwards, or the original one."

Now, as the remaining two were not, by Brosi's own testimony, made till July, 1861, and by Erbe's testimony not till he applied for his patent in 1864, it follows that if the witness did not know which one of the locks it was which he saw on the door, he could not know whether it was before or after the time of the making the two additional locks, that he saw the one on the door.

At folio 78 he modifies his answer as to the time of year when he saw the lock on the door, and says that he *believes* it was during the winter; and then adds that that is the best answer he can give on that subject.

He then [folio 78] testifies to the following nonsense:

"X. Q. 165. When did you last see it on that door? State as nearly as you can.

"A. I cannot remember the time.

"X. Q. 166. Can you not remember as nearly as you can?

"A. No, sir."

This witness repeatedly says that he did not know whether or not the lock he saw on the door was the first one which Erbe showed him, and then as often says that it was the first one, because they had no other like it.

There are several circumstances which bear with crushing weight against the truth of the statements of Brosi.

First—Erbe was foreman in the shop. Patterson was superintendent. Masta was pattern-maker and Brosi was a workman. Now, in this shop where all

these men were thus engaged, Brosi says two locks in addition to the first one were made by Erbe, and that he saw them in progress; saw them after finished; saw them in Erbe's drawer, and saw them about the shop, and examined them so closely as to look into the spindle hole and see a divided hub. Now all this occurred with Brosi, and yet neither Patterson nor Masta saw or heard of any lock but the first one; and these were the two men of all others whom Erbe would have shown any additional lock. He did show them his first. Yet Brosi was the only man who saw the two additional locks.

Second—This Brosi says a lock of the kind in question was on the door of the office of the proprietors of the the establishment, and that he saw it there as he went out and in. Now, which of the three—the superintendent Patterson, the pattern-maker Masta, or the workman Brosi—would naturally have most business at the office of the principals, and which, therefore, would have been most likely to have seen and recognized the lock on the door? Clearly, Brosi would have been least likely to have had occasion to go to the office of the principals, and least likely to see the lock; and yet, according to the evidence, Brosi is to be taken as the only one who saw the lock on that door.

Erbe himself swears [folio 48] that he never knew of such a lock being applied to a door before the time of his application for a patent, which was in 1864.

Third—Now, if such a lock was ever on the office door of the principals to test it, they, more than any one else, would have known all about it. But none of

them are among the Appellees' witnesses. It seems that the Appellees elected not to call them as witnesses. Too well they knew that they could not maintain Brosi's story by any one but himself, and that if those principals had been called as witnesses, instead of corroborating, they would have contradicted Brosi. And how absurd it is to suppose that that lock was tested on a door without Erbe's participating in it, or even knowing it.

Patterson shows that the usual way of testing locks was to put them on a door, and that putting them on a door was deemed to be necessary in order to test them. He says it was their uniform practice to test new locks by putting them on doors. From this it is obvious that if a lock was produced, considered finished, and was regarded as worth testing, it would have been put on a door to be tested. And yet the evidence entirely fails to prove that any such test or any test was made of this Erbe lock.

This circumstance again goes far to show that what Erbe did was a mere experiment, not considered worth following up, and that what he did produce was not considered worth testing in the usual way.

The Court below decided that the lock was never put upon a door.

Third—The allegation that the exhibition which Erbe made of the lock to the three persons was such a use of it as the law requires to entitle it to defeat a patent, cannot be sustained. It did not amount to even an EXPERIMENTAL *test of the invention.*

There was a customary way, in that establishment, of testing new locks; this was not applied to the Erbe lock.

Patterson swears that the usual way of testing new locks was to apply them to a door. Any one's common sense ought to teach him that the natural way to test a new thing is to try it under the circumstances under which it is intended to be used.

The strenuous effort made on the part of the Appellees to prove that the Erbe lock was put upon a door shows that they and their counsel realized and appreciated the necessity of showing that such a test of it was made. But, failing in this effort, they were reduced to the necessity of denying what their previous action had affirmed, by asserting and endeavoring to maintain that proof of such a test was not necessary, and that Erbe's manipulation of the lock with his fingers was a sufficient substitute for the usual practical test of it on a door. But, even in this attempt, the proof fails to show that there was such a manipulation of the lock as either exhibited or brought into action the functions and relations of its several parts.

There is no evidence that Erbe ever withdrew the latch or reversed it in presence of any one, or that any one ever saw that done with his lock.

The invention involves the joint use and action of the lock case, the latch, the hub and the knob spindle. The peculiarity of the invention cannot be exhibited while the knob spindle remains in the lock.

The latch does not exhibit its operation unless the spindle be withdrawn, so that two things are shown: first, that the latch can be drawn forward and turned around; second, that the spindle hole, when the latch is drawn forward, is in whole or in part covered by the hub; third, that on releasing the latch, after being drawn forward and turned, the hub will uncover the spindle hole so that the spindle may be inserted therein.

There is no evidence that these essential peculiarities of the lock, or any of them, were exhibited to any witness or person.

They could not have been exhibited without withdrawing the spindle from the spindle hole, and there is no evidence that this was done, or attempted to be done. On the contrary, there is intrinsic evidence in the lock itself that it was not done. The parts are so constructed and combined that if the spindle be withdrawn they will so separate and become displaced as to require more time and attention to re-adjust them than was practicable in the time occupied by the witnesses in looking at the lock. Without the presence of all those parts there could not be an embodiment of the invention. The exhibition of anything less than all of those parts was not an exhibition of the invention.

All that the witnesses say respecting the Erbe lock may be true without an exhibition to them of or without their seeing or understanding the peculiarities of the invention, or seeing how it operated.

It is true that the witnesses say that the lock contains certain peculiarities, but they do not say that they *saw*

those peculiarities, and leave it open to be understood, which was undoubtedly the case, that Erbe showed them the lock generally, and then, or subsequently, mentioned to them certain peculiarities. This evidence to any one who has had experience in such matters bears unmistakable marks of what the facts were, that is, that Erbe cursorily showed them a lock, without much attention being given to it, or of its being thought of any importance, and that the matter so remained until after litigation commenced on the Kirkham patent, when Erbe instructed them in all he knew about the peculiarities of the lock.

A feeble attempt seems to have been made on the part of the Appellees, by the testimony of Patterson, [page 48, folio 95, of the record,] to justify Erbe's laches in not perfecting the invention and applying for a patent, by proving that Jones, Wallingford & Co. did not dare to manufacture the lock from fear that it would infringe a patent belonging to another party. Such a fact constitutes no excuse for Erbe's delay.

When an infringer, to protect himself, has recourse to an old, secreted prior invention, made by somebody who had no idea of perfecting and patenting it, it is no uncommon circumstance for him to attempt to remove the presumption against such an alleged invention by offering some special reason why the invention was not further prosecuted and a patent applied for. Many frivolous things have been resorted to for such purpose, but the circumstance offered in this case to protect Erbe from the consequences of his laches is not only frivolous, but has no bearing whatever on the point at issue. It amounts to this: that Erbe did not perfect the invention and

apply for a patent because another party did not dare to manufacture the article. What had this to do with Erbe's applying for a patent? His applying for a patent, and his receiving it, if entitled to it, did not depend upon any particular parties manufacturing the lock. An inventor to justify his delay in applying for a patent sometimes proves pecuniary inability, but nothing of that kind is attempted to be shown in this case. An important part of the policy of the patent law is to have an invention made public as soon as perfected. And if the inventor desires protection, then to have it published by an application for a patent, so that others may have knowledge of it, and therefore not spend time and money in an effort to accomplish the same thing. If a number of persons are engaged in a search for a lost article, and one finds it, it is important for him to announce it to save the others from continuing the search.

An inventor before entering upon the labor of improving the means of accomplishing a piece of work, has recourse to the Patent Office to ascertain whether or not it has not already been done. If it has, and has been published in the Patent Office, he is thereby protected from a needless expenditure of time and money. But against a secreted prior invention, he has no way of protecting himself from such waste. Such losses it is a part of the policy of the law to avoid, and to accomplish this, to have an invention when made published in the Patent Office, and no circumstance is allowed as a justification to an inventor for neglecting this unless it be such inability on his part as renders it practically impossible for him to apply for his patent. No such inability on the part of Erbe is shown or attempted to be shown in this case.

III.

I WILL NOW CALL ATTENTION TO SOME OF THE LEADING AUTHORITIES ON THE SUBJECT OF WHAT IS NECESSARY IN A PRIOR INVENTION TO RENDER IT SUFFICIENT TO DEFEAT A PATENT.

It will not be sufficient to defeat a patent, for the Defendants' evidence to raise questions of doubt and uncertainty respecting the existence or non-existence of a prior invention, or respecting its degree of completion, or respecting the extent to which it was made public, or respecting the extent to which it was reduced to practice. These are all questions on which Defendants hold the affirmative. The testimony on all of these points must be—

First—So far free from doubt and uncertainty as to be entirely satisfactory to the Court.

Second—It must show that the invention was not only made, but reduced to practical form, ready for use.

Third—It must show that the invention was not only made and reduced to practice or to practical form, but that such reduction to practice did not end in simple experiment.

Fourth—It must show that such invention was not only completed in practical form ready for practical use, but that it was either made public or so put in the way

of becoming public as to furnish reliable assurance that the public would have received the benefit of it from such prior invention.

The law, as established by numerous decisions of courts, supports these propositions.

A very early and leading case on this subject was that of Bedford *vs.* Hunt *et al.*, 1 Mason, 302, which was contested by two very able counsel on each side, and was before one of the most distinguished Judges of his time.

There were two leading questions in that case. The second one was this:—

> "Into how general use a prior inventor must have introduced an invention or improvement in order to render void the privileges of a subsequent patent."

On this question Justice Story instructed the jury that—

> "The first inventor who has put the invention in practice, and he only, is entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent right upon proof of such prior invention being put into use."

In speaking of the rights of the defendant, he said:—

> "He may stand upon the defence that the plaintiff is not the first inventor *who put the invention in use.*"

Again, he said:—

> "The intent of the statute was to guard against defeating patents by the setting up of a prior invention, *which had never been reduced to practice.* If it were the mere speculation of a philosopher, or a mechanician, which had never been tried by the test of experience, and never put into actual operation by him, the law would not deprive a subsequent inventor, who had employed his labor and his talents *in putting it into practice*, of the reward due to his *ingenuity* and *enterprise.*"

This case makes a *practical use* of the invention, not a mere experimental use to test it, necessary, as well as the *fact* of a prior invention, to render it capable of militating against the rights of a subsequent inventor, under whom a practical use had grown up, or to whom a patent had been granted.

See also—

> Reed *vs.* Cutter, *et al.*, 1 Story R., 590.
> Woodcock *vs.* Parker, *et al.*, 1 Gall R., 438.
> Washburn *vs.* Gould, 3 Story R., 122.
> Allen *vs.* Blunt, 2 Wood. & Minot, 121.
> Curtis on Patents, Sec. 43.

In the case of Parkhurst *vs.* Kinsman, 1 Blatchford R. 488, 494, the same doctrine was held.

In that case the complainant's patent was granted in May, 1845, and machines had gone into use under it. The defendants set up, as a defence, a prior invention of

10 How. 497
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one Sargeant, and proved that as early as the Spring of 1843 Sargeant made both a drawing and a working model of the invention, and put the model in operation to test it, and exhibited it to several persons, and that it worked satisfactorily. That after such repeated trials and exhibitions he allowed it to remain, retaining his model, until after the complainant had made *his* invention and obtained a patent.

Here, then, was an *invention*, a *model machine*, constructed and operated to test its sufficiency, and only two years before the date of the complainant's patent, yet the learned Court did not hesitate to unanimously decide that it was not such an invention as would affect the subsequent patent, and that in the sense of the patent law the complainant was the *first* inventor.

At page 494, the Court says:—

> "It is not enough to defeat a patent already issued, that another conceived the possibility of effecting what the patentee accomplished. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. It must have been carried into practical operation; for he is entitled to a patent who, being an original inventor, has first perfected the invention, and adapted it to practical use. Crude and imperfect experiments, equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent."

In the case of Gayler *et al. vs.* Wilder, 10 Howard 498, this court held that where the facts of a prior invention are such as to show that, by its having been forgotten, or the machine constructed having been lost, or from any other casualty or circumstance, the public would not have been likely to derive any benefit from it until it was discovered by another inventor, it was not a prior invention within the meaning of the law.

In the case of Many *vs.* Jagger, 1 Blatch. R., 372, the invention was casting car wheels with double convex plates. It was proved that one Baldwin had cast three of the wheels before Wolf's (the patentee's) invention.

But the Court held that this was not a sufficient reduction to *practice* to defeat the subsequent patent.

Under the laws of England, although it is required in terms that the invention, to be patentable, must *be new in the kingdom*, yet this does not mean *new* as against barren conceptions, or experiments not made public, but it means *new* only within the meaning of the law; and in that country, to satisfy the meaning of the term *new*, it is only required that the invention be new *to the public* within the kingdom.

Hindmarch on Patents. Edition printed at Harrisburg, Pa., 1847, pp. 106 to 109.

In Lund on Patents, page 8 (marginal), it is said that—

"Use in public is the definition of an old invention." Meaning, of course, practical use in public.

Judge Kane. in the case of Parker *vs.* Hulm, 1 Fisher, 53, in charging the jury, said:—

> "It is not enough to defeat a patentee's right to show that a machine had been *made*, but it must be also shown that it had been *used* before the Plaintiff's invention. This is the test of what is required to defeat the title of the patentee."

Justice Grier, in the case of Crandle *et al. vs.* Lippincott *et al.*, tried in the Western District of Pennsylvania, in 1853, and reported in the 26th volume, 3d series, page 10, of the Franklin Journal, in charging the jury, said:—

> "The mere speculation of a philosopher or mechanic, never put into actual practice or operation, will not deprive a subsequent inventor, who has employed his labor and talents in putting it into practice, of the reward due to his ingenuity and enterprise."

Judge Leavitt, in the case of Judson *vs.* Moore *et als.*, tried in the District of Ohio, in 1860, 1 Fisher, 544, in charging the jury, said:—

> "Experiments of another, even if known to a patentee, will not defeat the claims of such patentee to originality of invention, if it appear that such patentee has prosecuted such experiments to success."

See also:—

Allen *vs.* Hunter, 6 McLean, 321.
Foote *vs.* Silsby, 2 Blatch., 266.

Howe *vs.* Underwood, Mass., Sprague J., 1 Fisher, 160.

Ransom *vs.* Mayor of New York, 1 Fisher, 252.

A leading case on this subject is that of Cahoon *vs.* Ring, which was tried before his Honor, Justice Clifford, in the District of Maine, 1 Fisher, 397. In that case the learned Justice, in charging the jury, and speaking of a machine set up against the patent as a prior invention, said:—

> "Should you find that it was made and *completed* prior to the Cahoon invention, and that it does embody the improvements in the Cahoon patent, as already defined and explained, you will then inquire whether it was, in point of fact, a machine completed and reduced to practice, in contradistinction to an experimental machine, or a machine made by the supposed inventor, in the prosecution of experiments and enquiries, and that, unless it appears to your satisfaction that such machine was *actually used as a seed sower in sowing seed for agricultural purposes*, you are warranted in presuming that it was a mere experiment, and if so, you are instructed that it would not invalidate the plaintiff's patent, provided Cahoon was an original inventor of his improvements without knowledge of that machine, and did not derive any of them from Luce."

The learned Justice also instructed the jury that where a single specimen of a machine was made,

"whether capable of use and whether actually used or not by the party making it for the purpose of testing its operation," if it disappeared, "so that the public could not derive the knowledge of it from the machine itself, the existence of such prior machine will not invalidate the patent under consideration, even if the invention of the patentee was subsequent in date."

In the case of Eli W. Blake *vs.* George W. Rawson, decided October term, 1872, reported in the Patent Office Gazette, vol. 3, No. 5, page 122, Judge Shepley, of the First Circuit, held that proof of the existence of only one machine, and that, twenty years before the patent, would not invalidate the patent.

The same learned judge, in the same year, in the case of Murphy *et al. vs.* Eastham *et al.*, reported in the Patent Office Gazette, vol. 2, No. 3, page 61, held in the words of the head note thus—

> "Things relied upon to defeat a patent on the ground of prior invention, but which were never put upon the market, never came into practical use, were never sold, and were not thought worthy of preservation, held to be experimental."

The prior production of a single specimen of the article patented was not alone sufficient to defeat a subsequent patent for an independent invention. The patent in that case was issued to McLaughlin for an improved brush. The respondents furnished evidence of the prior existence of three brushes, which they contended were like the one patented.

The learned judge, in reference to the prior brushes, says :—

> "Whatever they were, and whenever and howsoever constructed, they were mere experiments. They were never put upon the market; they never came into practical use; they were never sold; they were not even thought worthy of preservation, and cannot now be found."

All this, and more, can be truthfully said of the Erbe lock. It was never put upon the market; it never came into practical use; it was never sold; it was not thought worthy of preservation; it cannot now be found; it, therefore, by the doctrine of this case, was a mere experiment.

In the case of Parham against the American Button Hole Overseaming and Sewing Machine Company, in the Third Circuit, decided in April, 1871, and reported in 4 Fisher's Patent Cases, 470, it was held that the existence of two machines, with even a limited experimental use of them prior to the invention of the patentee, was not sufficient to invalidate the patent. The patent was dated November 21, 1854. The invention was proved to have been completed early in 1852. Two machines were set up as prior inventions, and were held by the Court to be insufficient to affect the patent. The facts concerning them the Court states as follows, pages 476 and 477 :—

> "The Fisher machine (Exhibit No. 1) was made by Fisher in the early part of 1850, and was the model from which the Fisher-Wickersham

machine (Exhibit No. 2) was constructed by Wickersham, in the latter part of the same year. They are substantially the same in the principle of their operation, the only notable difference between them consisting in this, that in the first the movement of the shuttle is in the arc of a circle, and in the latter in a horizontal line. Their history is somewhat extraordinary. The first one was made by Fisher, and he never saw it in practical operation. It was made for E. D. Leavitt, and the only use he knew or 'thought' was made of it is stated in his answer to the thirty-eighth cross-interrogatory propounded to him: 'I think samples were sewed by it, enough to show the working of the principle, but very little.' It was delivered to Wickersham as a model for a duplicate, and remained in his shop at the Mechanic Mills, at Lowell, until 1857, when it was disentombed from the attic of that establishment, and carried to Boston to Martin and Rufus Leavitt, by whom it had been purchased. To them it belonged when the proofs were taken. At no time, during all this period, was it employed in any operative use, except as stated by E. D. Leavitt.

"The Fisher-Wickersham machine was delivered to E. D. Leavitt, in October, 1850, and he sewed with it a pair of pants and a jacket for a small boy, and a pair of pants for a larger boy. It was kept most of the time until April, 1857, in a small room up-stairs in his house, when it, also, was sold to Martin and Rufus Leavitt, for $200, but no use was made of it during this time, not even by Leavitt's wife in making clothing for their chil-

> dren. When the Leavitts got it, it was boxed up, and only taken out to be used in a lawsuit in Baltimore, after which it was returned to the box, and remained there until it was reproduced in this case."

The doctrine of this case would summarily dispose of the Erbe experiment.

In the case of Roberts *vs.* Dickey, 4 Fisher's Patent Cases, 532, decided by Mr. Justice Strong in May, 1871, where the patent was granted to Roberts for a method of increasing the capacity of oil wells, alleged prior inventions are disposed of by the following language:—

> "Roberts was then the first to reduce the method invented to *actual and successful practice*, and all that was done by others may be properly classified among unsuccessful experiments. However suggestive they may have been, they cannot be made available to defeat a patent granted to an inventor, who subsequently, to the failure of others, *reduced his idea to practice, and revealed to the public* a useful process which the crude and fruitless experiments of others had not made known."

Here again the doctrine is clearly asserted that only the inventor must be protected by the patent law, who puts himself within the policy of that law. He must do something more than make an experiment. He must make the invention; but that alone is not enough. He must reduce it to *practical form*, and that is not enough, for this he might do and bury or sink in the ocean the

single specimen so reduced to practical form. He must reduce it to "*actual and successful practice*," or in some other way reveal it to the public, or put it into a condition so that with reasonable certainty a knowledge of it will reach the public.

The same doctrine was stated by Mr. Justice Nelson in the case of Ross Winans *vs.* N. Y. & Harlem R. R. Co., 4 Fisher, 9, wherein he says:—

> "It is not the person who has only produced the idea that is entitled to protection as an inventor, but the person who has embodied the idea into a practical machine and reduced it to *practical use*. He who has first done that is the inventor who is entitled to protection."

Such is the law of this country. The law, as settled in England, is to the same effect. A prior invention there to defeat a patent must have been completed, reduced to practical form, and communicated to the public, or something else must have been done with it giving reliable assurance that the public would have received it from some such prior invention. Anything short of this will not defeat a subsequent patent for an independent invention.

The following cases sustain these positions:

Cornish *vs.* Keen, 1 Webster's Patent Cases, 501.

Household Co. *vs.* Neilson, 1 Webster's Patent Cases, 673.

Galloway *vs.* Bleaden, 1 Webster's Patent Cases, 521.

Dolland's Case, 1 Webster's Patent Cases, 43.

Hill *vs.* Thompson, 1 Webster's Patent Cases, 239.

Jones *vs.* Pearce, 1 Webster's Patent Cases, 122.

Lewis *vs.* Marling, 1 Webster's Patent Cases, 490.

Liardet *vs.* Johnson, 1 Webster's Patent Cases, 53.

Carpenter *vs.* Smith, 1 Webster's Patent Cases, 530.

Carpenter *vs.* Smith, 1 Webster's Patent Cases, 540.

Elliott *vs.* Asten, 1 Webster's Patent Cases, 222.

IV.

TO ALLOW SUCH AN EXPERIMENT AS THAT OF ERBE TO INVALIDATE THE KIRKHAM PATENT WOULD BE IN DIRECT CONTRAVENTION OF BOTH THE OBJECT AND THE POLICY OF THE PATENT LAWS.

The policy of the patent laws as declared by the Constitution is to promote improvements in the useful arts. The thing to be promoted is not *barren experiments*, but it is the *making of improvements* and the *imparting a knowledge of them to the public.* One who fails to reach the public with his improvement fails to do what

the law is intended to encourage, and therefore fails to entitle himself to the benefit of the law. A man may experiment and invent, and make great progress in his individual knowledge of useful arts, and become very learned therein, and never impart any knowledge of his achievements to the public; but this would not be such a promoting of the useful arts as is contemplated by the Constitution, or which the patent laws are intended to encourage. Such would be of no use to the public. The Constitution would more accurately express its object if it read: Promoting public knowledge in the useful arts.

The object of the patent laws of all countries is public good. It is to furnish the public with new and useful inventions and discoveries, and anything short of this does not come within the policy of those laws, or constitute what those laws are intended to encourage. It is not the man who invents and secretes, but the one who invents and promulgates who is intended to be rewarded by the patent laws. These laws are intended to encourage and stimulate inventive genius to penetrate unexplored regions of nature, and bring out and pass over to the fund of public knowledge, for public benefit, useful things previously unknown. It is not the policy or object of those laws to encourage persons to make inventions, experiment upon them, and then leave them in experiment, or, if completed, leave them barred from public knowledge. To allow such experiments to defeat patents for subsequent inventions made by others would be to directly contravene and counteract the intention and only justification of those laws, and cause them to *dis*courage what they were intended to *en*courage; because then an inventor about to enter upon an exploration to find out

and to invest means to work out an invention would be confronted and discouraged by the probability that after spending his time and money in study and research, and producing and patenting a useful thing, he would be liable, as soon as it was made public, to be met and defeated by some private experiment or secreted invention which some other one might have made years before, which he knew nothing of, and had not the means of knowing anything of, and which would have remained in oblivion had it not been exhumed therefrom by the publicity given to it by the patentee's subsequent invention. To allow a mere experiment to intercept and defeat one who has complied with the law by originating an invention and promulgating it to the public by obtaining a patent, would be gross injustice, as well as directly against the policy of the patent laws.

When an inventor has made his invention, obtained his patent, and the invention has gone into public use under his patent, to allow a mere secreted prior invention to invalidate his patent is not only against the public interest, and with discouragement to inventors, but it does this by breaking up a settled state of things which had been established pursuant to and in accordance with the policy of the laws of the land, and it therefore becomes a very serious matter; so that those whose duty it is to execute the laws, always have struggled and always will struggle against such a result.

Hence it is that the Courts have ever been careful to discriminate between the claims of those who come within the policy of the law by making an invention public, and those who merely experiment or secrete their

discoveries. The former adopt the law and are loyal to it, and are therefore entitled to its benefits, while the latter repudiate the law, are rebels against it, and are therefore held in disfavor under it.

The case under consideration is especially one where such discrimination is called for, and nothing could go forth from this Court which would so much chill the inventive genius of the country with disappointment and discouragement as to allow the experiment of Erbe to defeat the Kirkham patent.

Viewed in the light of the policy of the patent law, the Kirkham patent has the strongest possible claim to protection from these laws, while the Erbe experiment has no claim at all to protection from them.

The Kirkham invention is the *ward* of the patent laws; Kirkham early put it under the guardianship of those laws by complying strictly with all their conditions and requirements; it is their child, and entitled to their kindest care, while the experiment of Erbe is a rebel to those laws, and has justly incurred their condemnation.

As soon as Kirkham made his invention, like a proper subject of law, he hastened to promulgate it to the public by the procurement of a patent and putting it into use, while Erbe, after making his experiment, recklessly inattentive to the requirements of law, slept for nearly four years without doing anything. Nothing for public good ever grew out of the Erbe experiment; no one ever used or pretended to take or use the invention from that experiment. All the benefit which the public have received or are receiving or ever would have re-

ceived is due entirely to the invention of Kirkham. What Kirkham did was in exact conformity with the policy, intention and provisions of the patent laws. What Erbe did was not in conformity with the policy, intention or provisions of those laws; on the contrary, Erbe did just what those laws are designed to *prevent;* that is, leaving a thing in experiment and not making it known to the public.

When Kirkham made his invention, nothing like it was in use or ever had been; nothing of the kind had ever been produced and imparted to the public; nothing of the kind had ever been produced and put on the way to public knowledge, so that it would of necessity or even probably ever have reached that goal.

Under this state of things, the patent law by its promises of protection, invited Kirkham to embark in the enterprise of an effort to produce the invention. He accepted the invitation, and entered upon the work. The bargain thus made between Kirkham and the public, was, that if he on his part could and would make the invention, procure a patent, and without delay so describe the invention on the records of the Patent office, that the public could have the free use and benefit of it after the limited term for which the patent would be granted, that they, on their part, would, through the instrumentality of their laws and Courts, protect him in the exclusive use of it for the term of the patent. Kirkham kept and performed this bargain to the letter. He made the invention, he procured his patent, and without delay spread the required description upon the records of the Patent office. What follows? Why, while he

(Kirkham) and the public were mutually progressing in the execution of their agreement, and after the lapse of some seven years, a party in disregard of this solemn contract between Kirkham and the public, is discovered to be infringing the patent. Kirkham, relying upon the good faith on the part of the public in keeping their part of the contract by protecting him, institutes a suit, and invokes the aid of their Courts, whereupon, he is confronted, not by anything which he had ever before heard of, not by anything known to the public, not by anything done by the parties seeking aid from it, and not by anything which the public were in possession of at the time of making their bargain with him, but by an abandoned or secreted experiment made years before, and exhumed from oblivion by infringers only to deprive Kirkham of his promised protection.

Any laws admitting of and so administered as to produce such a result, are unjust, deceptive, and also suicidal by defeating their own object in *dis*couraging instead of *en*couraging improvements in the arts.

This Court more than any other is commissioned with the high and important duty of carrying out the object and policy of the patent laws, and it undoubtedly is the most important interest for the advancing prosperity of the country of which this Court is the guardian. Our mighty and faithful army of inventors are laboring under the strong and inflexible arm of protection of this Court, and just in proportion as that arm becomes enervated, or that protection becomes relaxed, they become the prey of hordes of infringers who are ever on the alert to filch from others what they had neither the ability nor industry to produce themselves. By the in-

fluence of well administered patent laws inventive genius has become the most productive source of natural wealth and power. Deal fairly with it, uphold and encourage it, and its power and endurance will acknowledge no impossibilities, and its course will be steadily onward; but embarrass and discourage it by allowing infringers to invoke still-born, barren and forgotten experiments to raise them from oblivion and clothe them with the attributes and dignity of invention to rob the true inventor of the just fruits of his genius and toil, and you will paralyze the future operation of that mighty invisible power which gave the country the honor and benefit of the cotton-gin, the telegraph, the sewing-machine, the monitor, the locomotive and the reaper.

Such would be the result of defeating the Kirkham patent, even if this were a controversy between two inventors, as between Kirkham and Erbe. But the case is worse than that; it is not a controversy between two patentees nor between two inventors. It is a controversy between a patent and its infringer. On one side is the representative of one who originated the invention, procured a patent for it and laid it before the public; on the other side are persistent, defiant infringers, neither possessing nor claiming any merit of invention, but treating such claims and the law for their protection with contempt. The use sought to be made of the Erbe experiment is to defeat the rights of a party which have come to him through the exact channel prescribed by the constitution and laws. The parties who seek to avail themselves of this experiment of Erbe are

not those who would have been pleased if the experiment had been carried out and a patent obtained for it. They have no sympathy for or admiration of that experiment except in so far as it may be available to protect them from the consequences of piracy. They knew nothing of this experiment before suit was brought against them; they hunted long to find something on which they could build a pretence of a defence, and finding this, set it up and use it—not because they have any respect for it or its author, but merely to justify them for acts which they committed without any knowledge of the existence of anything which would justify them. They, with impunity and contempt for the patent, infringed it, and, when sued, compassed land and sea to find protection, and, having hit upon this experiment of Erbe, use it as their only and last hope.

GEORGE GIFFORD,
Counsel for Appellant.

SUPREME COURT

OF THE

UNITED STATES,

No. 38.

PAUL C. COFFIN,

Appellant,

vs.

JAMES B. OGDEN,

AND

LUCIUS WOODRUFF,

Appellees.

REPLY TO BRIEF FOR APPELLANT.

PROVIDENCE:
HAMMOND, ANGELL & CO., PRINTERS.
1873.

Supreme Court of the United States.

PAUL C. COFFIN,
Appellant,
vs.
JAMES B. OGDEN and LUCIUS WOODRUFF.

REPLY TO THE BRIEF OF MR. GIFFORD.

It is not conceded that "Kirkham made his invention and put it into public use before Erbe attempted either to develop his invention or make it known." (p. 2.) It does not appear in the record by any proof, and the appellees do not understand it to be the fact that Kirkham, or any of his assignees, ever constructed reversible latches after his plan, or that any parties have taken licenses under his patent. On the contrary, the proof clearly shows that not more than *two* latches of this kind were ever made. One of these is an exhibit in this case; the other is filed as a model in the Patent Office. *Albert M. Hill*, Record, p. 65.

> Q. 19. "How many models or completed locks were made at or about this time, exhibiting the Kirkham improvement?"
>
> A. "There were certainly two, and if I remember right, but two."
>
> Q. 20. State what was done with those models, so made, if you know?

A. "One model was sent to Munn & Co., in connection with an application for a patent, and I suppose went to Washington; my impression is that the other was sent to Charles A. Miller, of Philadelphia."

Miller, the only witness called by the appellant on the Kirkham invention, produces the lock sent to him, and it is marked Exhibit C, in this case. He is asked,

P. 19. Q. 62. "How many locks like exhibit C, were ever made to your knowledge?"

A. "I don't think there has ever been a half-dozen made by Kirkham under that patent of June, 1861."

Q. 63. "Of how many have you any actual knowledge aside from your belief?"

A. "Three or four."

It is conceded by the Appellant (Brief, p. 2), that Erbe, "as early as the first of January, 1861, made a lock containing the elements of the combination patented," and that he exhibited the same to several persons, and delivered it into the hands of his employers, Jones, Wallingford & Co.

It was not a model, exhibiting an idea, but it was a completed operative structure, containing a latch which could be reversed at pleasure, so as to be adapted to either a right or a left hand door. See depositions of *Brosi*, *Masta* and *Patterson*.

The new thing which the structure contained was the means for enabling the latch to be reversed, and this new thing could only be put into use in any proper sense, except when the lock case in which it was contained, was not permanently fixed upon a door. The reversible mechanism of a latch ought never to be put to use but once during the life of the structure. When the "hand" of the latch is once settled by the joiner, who is about to affix the structure to a door, the usefulness of the reversible mechanism is ended forever. The concession therefore of the appellant—the propriety of which is sustained by the uncontradicted proof in the record—that Erbe did, in fact, as early as the first of

January, 1860, make a latch containing the elements of the combination patented, and that the same was publicly exhibited, carries with it as a necessary consequence, the conclusion that the invention was reduced to practice or use in the only way in which it was susceptible of reduction to use.

Erbe did not apply for a patent until 1864. This is a false issue. The question is not whether Erbe forfeited his right to a patent by his delay in making an application for a patent, but it is whether he had prior knowledge of the thing subsequently invented by Kirkham. Abandonment or forfeiture of right by Erbe does not enure to the benefit of Kirkham, but to the public.

The attack which is made upon the witness, *Brosi*, is unfair and wholly unjustifiable. All that he testifies to is confirmed by *Masta* and *Patterson*, (witnesses against whose credibility no impeachment can be made,) with the exception of the circumstance that the Erbe lock was put upon the office door, with other new locks, and in this particular he is corrorborated by Patterson and by Erbe. It is true that the witness speaks English less fluently than German and is, therefore, more capable of being confused by being made the subject of a cross-examination extending through one hundred and fifty-nine questions, but his statements are consistent throughout.

The cross-examination opens with an inquiry as to whether in another controversy upon the same subject, he had testified to the same purport as in his testimony in chief. No attempt is made to show that his testimony on any former occasion was in any respect different.

The witness does not intend to say that Erbe made two other locks like exhibit A, immediately after he made the first one, but that Erbe made two *after* he made the first, and that he does not mean immediately after the first lock was made, is clear from the statement in

answer to Q. 101, to the effect that this was done after the shop commenced work following the long suspension of the business in the winter of 1861. *Patterson* says, (Q. 3,)that the works "did suspend about the first of November, 1860. They did not resume again in full force for many months." Undoubtedly these two additional locks were made some time later than the first one, but they were repetitions of the original structure.

The supposed contradiction in reference to the exhibition of these locks at different times to a shopmate, John Rabitzky, is too trifling to be worth consideration.

When he says, in answer to question 130, that there was no other lock in the shop like Exhibit A, he means evidently that no lock of the kind previously existed, and the confusion attempted to be created by asking him if he had not already sworn that Erbe had made two other locks, is created by the examination and not by the witness, and does not justify the assertion in the brief. "Here he flatly contradicts himself in the short space of answering three questions."

The quotations from the testimony, Q. 139 to 141, distort the meaning of the witness by the omission of his answers to the three following questions.

Again, the quotation of answers to questions 148 and 149, unfairly represents the witness by the omission of his answer to question 150.

The witness, although an intelligent mechanic, is perhaps unfortunate in being a German by birth, but this circumstance hardly warrants the degrading epithet, "indomitable Dutchman," applied to him on page 13 of the appellant's brief. His statement is a straight-forward and consistent one, except where, from the manner of

the examination to which he was subjected, he was involved in some confusion, owing largely to the circumstance that he is not a complete master of the language. Thus, when asked if he saw the *internal* works of the Erbe latch that was put upon the office door, he replied, "Yes, I did. We have to go through that door." And when asked, Q. 129, for an explanation of what he understood by the terms, "its internal works," he answers, "the opening and shutting the door again." The statement which he gives and which, where a reasonable allowance is made for his misapprehension of the questions is entirely clear, is this. Erbe exhibited his completed reversible latch to him on Christmas day, 1860. This same lock was placed upon one of the office doors in the counting-room of Jones, Wallingford & Co. The factory suspended business for several months, during the winter of 1860–1861, and after work was resumed Erbe made two other reversible locks like the one which he first made.

The offence of Brosi is, that he testifies positively to the circumstance that the original reversible Erbe latch was placed on one of the office doors, as was customary with new locks.

A point is made on page 16, that the Appellees have not called Jones, Wallingford & Co., to confirm Brosi in his positive statement that the lock was put upon the door and corrorborate Erbe and Patterson in their belief that it was so tested. These parties have their reasons for being unfriendly to the Appellees. If the fact were not as Erbe and Patterson believe it to have been, and as Brosi states that it was, their relations to the Appellant would be an assurance that the Appellant would have produced them as witnesses.

Mr. Woodruff, in answer to a question as to his efforts to procure the personal attendance of witnesses before the Examiner, in New York, says, page 49, folio 97:

"I did make strong efforts to procure his (Erbe's)

attendance at this examination. I saw him first on this last visit to Pittsburg, in the office of Jones & Numich Mf'g Co., in Mr Jones' presence, on Thursday morning of last week, I told him that our suit was coming on in New York, and that I had come there for the purpose of getting himself, Mr. Patterson, and others, to go on to New York with me and testify in the case. He replied that he would be glad to go and testify in the case so far as he was concerned, and would do so, and inquired when I wished to start, &c. I replied, the following night, Friday night. At just this time Mr. Jones objected to his going, and to my talking with Mr. Erbe further on the subject. He said to Mr Erbe that he could not go to New York to testify in this case with his consent, and that he would do all he could to prevent the other parties namely, Patterson, Masta and Brosi, from coming. Mr Jones then said that he was in New York two or three weeks ago, and held a long consultation with Mr Gifford, on the matter of our obtaining these men as witnesses; that at the time he determined to prevent our obtaining them if possible. I saw Mr Erbe afterward, and on account of Mr Jones' treatment of the matter he could not come, as he was in Mr Jones' employ, at the same time again, saying, he would be glad to come."

In reply to point III. of the Appellant's Brief, it will be sufficient to say, that the law, as stated in the various cases which have been decided in the Federal courts, bearing upon the question of the sufficiency of an alleged prior invention to defeat a subsequent patent, there can be no serious difference between counsel. An unsuccessful experiment, or a conception not embodied in practical form, does not defeat a patent. Upon the other hand, it is not at all necessary that an invention, which can defeat a patent, should have been communicated to the general public, or have been put upon sale. Under our law, no person, who is not the first and original inventor, can lawfully hold a patent.

Clear proof that a single individual, made and adapted to use, a structure subsequently patented by another, will defeat such patent. Otherwise, disputes will arise in every case as to the extent of the public use necessary, and it would be impossible to fix any definite and settled rule as to how many persons constituted the public.

The question does not become material, perhaps, in this case, but it is erroneous as matter of law, to contend, that under our statute, limiting the right to a patent to the first and original inventor, that it is the duty of the first inventor, as a condition of being secure against an injunction against himself, on the suit of a subsequent inventor and patentee of the same thing, to show that he put his invention to use for business purposes, or that he had "put it into a condition so that with reasonable certainty, a knowledge of it will reach the public."

The various cases from the English reports, cited on page 32 of Appellant's Brief, have no application to the point upon which they are cited as authority. Under the English statutes, letters patent are granted to the person who first introduces the invention into the realm. The thing for which the monopoly is given, is —the introduction of an invention into the kingdom. Hence, to defeat a patent, a previous communication of the invention to the public, must be proved. The policy of the English law, is to stimulate the introduction of inventions, and it rewards with a patent the first introducer without regard to whether he is the inventor or not of the thing introduced. The policy of our law, is to stimulate the progress of inventions, by giving the patent to the first inventor, and if another than the first inventor has obtained a patent, such patent is liable to be defeated, upon the proof that the thing patented was previously known. It is

erroneous to say that an inventor who has not procured a patent, or introduced his invention into public use, cannot defeat a patent subsequently procured by another. Suppose an inventor, for example, has constructed a complicated machine, and relying of his protection against other parties making the same machine, upon the exclusion of all persons form his workshop, proceeds to put the machine into successful use for his own benefit and profit, and so employs it for years. Another person, working independently, subsequently makes the same invention. Is it true, that such subsequent inventor can sustain his patent against the proof of what was done by the previous inventor? If so, he could enjoin by force of his patent the first party from continuing a manufacture which he had carried on for years before the subsequent invention was made. In the argument of such a case, it would be contended on the part of the patentee, that the first inventor had failed to impart a knowledge of his invention to the public, and therefore, what he had done in constructing and using machinery for his own benefit, ought not to avail against a subsequent patentee. The obvious reply would be, that under the act authorizing patents, no one can have a lawful patent, who is not a first inventor. Concealment of the invention and delay in applying for a patent until after another has independently made the same invention, is a very good reason why the first inventor should not, after he had thus made his election, obtain the protection of letters patent, but it does not follow that the subsequently granted patent is valid.

The argument of the Appellant, in its concluding division IV., confuses the reasoning applicable to the question, whether a claimant should receive letters patent for an alleged invention, and that which belongs to a case where the validity of letters patent which have been granted, is in dispute. No inventor is under any obligation to patent his invention, and surely every man

has a natural right to use for his own purposes that which he has created, without disclosing the invention to the public. True, he cannot if he elects to rely upon the protection of his bolts and bars subsequently, after long delay, and especially after another has independently made the same invention and patented it, procure a patent. Upon the other hand, the subsequent inventor and patentee is not entitled to enforce his patent, for the sufficient reason that he is not in fact the first inventor. The improvement in such case goes for want of a lawful claimant, to the public. (*Kendall*, v. *Winsor*, 21 Howard.)

If the Erbe Reversible Latch was an experiment in the sense that it was an unsuccessful effort to make a reversible latch, then it furnishes and ought not to furnish any answer to the Kirkham patent. But if on the contrary, it was a finished operative structure, a thing which had passed beyond speculation into a reality, then whether Erbe engaged in the manufacture of the latch, or whether he communicated the invention to a public composed of any greater number of persons than Bernhard Brosi, Henry Masta, Andrew Patterson, and Jones, Wallingford & Co., is entirely inmaterial.

The learned Counsel for the Appellant has omitted one important element from the draft contract between Kirkham and the public, which is submitted on page 37 of his Brief, and that is the condition which the law implies as a pre-requisite of a valid grant, that it shall appear that the invention "was not known or used by others, before his discovery or invention thereof."

It is undoubtedly the duty of this Court, to uphold the laws. In this proposition of the Appellant, we concur, but we would add to the discussion upon this point the suggestion that the public have rights worthy of protection no less important than those of patentees. This controversy is not between Erbe and Kirkham,

for the purpose of determining which of the two ought, under the circumstances, to have a patent, and levy contributions from the public, but it is between the Kirkham patent and a manufacturer of locks, and the latter alleges that the corporation which he represents, constitutes a part of the general public, and that the right under the law to make and use the Erbe latch, has vested in it by the gift of Erbe.

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